

Application No. 10/753,270

Reply to Office Action

*REMARKS/ARGUMENTS**I. Office Action Mailed On October 28, 2005*

The first Office Action in this application, mailed on October 28, 2005, rejected all pending and not withdrawn claims as being anticipated by U.S. Patent Publication 2002/0128894 A1 ("Farenden"). This prior art rejection was the only reason cited for why the claims, as originally presented, are purportedly unpatentable. Notably, the Office Action did not reject any claim as being indefinite under 35 U.S.C. § 112, ¶ 2.

II. Interview On January 30, 2006

In response to the Office Action, Applicant (Anatoly Feygenson) and Applicant's representative (David Airan) met with Examiners Smith and Weiss (collectively "Examiners") on January 30, 2006. Applicant and his representative (collectively "Applicant") express their gratitude to the Examiners for the interview in this application.

At the interview, Applicant explained that the invention addresses various problems, including the problem of unemployed or under-employed workers, who collectively represent a vast untapped labor resource pool. The systems and methods described in the specification differ from a conventional recruiting and employment paradigm.

Applicant particularly pointed out that Farenden describes an Internet-based system for recruiting candidates for a conventional employment position. Farenden does not describe a system or method for contracting individuals to perform discrete units of work in exchange for payment, on a per-unit basis, for completion of this work. Farenden, which is directed to resolution of different problems than the systems and methods described in Applicant's specification, does not expressly or inherently describe the subject matter presented in the original claims of the present application.

At the interview, the Examiners appeared to agree with Applicant that Farenden does not anticipate claims 16-19. The Examiners, however, indicated that the interview would prompt the Patent and Trademark Office to conduct an additional search for more pertinent prior art than Farenden. Notwithstanding the lack of art describing the claimed subject matter, Applicant indicated that he would amend claim 16 to specify that (1) the work to be

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performed may be electronically transmitted over the Internet; and (2) the pool of potential contractors includes individuals who are capable of doing the work.

The Examiners did not indicate that the claims, as originally presented, were or are indefinite.

III. Office Action in Application Serial No. 11/273,459

Subsequent to the personal interview, the Examiners issued an Office Action in co-pending Application No. 11/273,459 ("the '459 application"), which is a divisional of the current application. This Office Action, mailed on February 14, 2006, includes several questions that, according to the Office Action, relate in some manner to an indefiniteness rejection of the claims in the '459 application under 35 U.S.C. § 112, ¶ 2. The Office Action in the '459 application also includes a rejection of all claims in that application as being obvious over U.S. Patent 5,918,207 ("McGovern") in view of U.S. Patent 6,356,875 ("Green").

Applicant will, of course, provide a more detailed response to the Section 112 and prior art rejections in the '459 application. However, to the extent that Examiners have similar "questions" in the current application as those raised in the '459 application, Applicant notes that the specification completely describes the invention and answers the precise questions raised by the Examiners. Applicant, moreover, respectfully submits that the answers to these questions need not be incorporated into the claim language to satisfy 35 U.S.C. § 112, ¶ 2.

The Federal Circuit has explained that a claim need not be "self-contained." *S3 Inc. v. nVidia Corp.*, 259 F.3d 1364, 1369 (Fed. Cir. 2001). The claims at issue in *S3* involved a video controller that produced video display signals. *Id.* A district court concluded, erroneously as it turns out, that the claims did not satisfy 35 U.S.C. § 112, ¶ 2 because they did not specify in a self-contained manner the source of a video signal. The Federal Circuit reversed the district court because the patent specification adequately explained the operation of the controller and other allegedly missing information. *Id.* Section 112, ¶ 2 did not require that the operational details of the circuit be repeated in the claims.

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The Board of Patent Appeals and Interferences in *Ex parte Lundgren*, Appeal No. 2003-2088, Application No. 08/093,516, moreover, has approved of the type of method claim presented in the current application and in the '459 application. The representative claim in *Lundgren* included highly similar language to the claims in the current application. It included, for example, steps such as "measuring," "determining," and "comparing" without specifying who or what conducted such steps. These claim terms were not indefinite in *Lundgren* and are not indefinite here.

Most relevant is that the claims in *this* application have not been rejected for indefiniteness, either in the original Office Action or during the Interview. Applicant respectfully submits that the claims of the current application, whether original, amended or new, are all sufficiently definite under the controlling Federal Circuit and PTO precedent.

IV. Claim Amendments

Applicant has amended claim 16 as discussed during the interview. This claim, as now written, indicates that the "the work is capable of being transmitted electronically over the Internet." It also indicates that the "pool" of potential workers "includes at least one applicant who is qualified to perform the at least one type of atomic unit of work." Applicant has also added claims 21 through 32. These claims recite the steps of selecting and paying a candidate on a per work unit basis.

V. Discussion of Prior Art

The Office Action rejected claims 16-19 as being anticipated by Farenden. As discussed at the personal interview, however, Farenden does not disclose the subject matter recited in claims 16-19.

In particular, Farenden does not disclose the "atomic unit of work" approach. Atomic units of work, as described in the specification, may be defined as activities that a business could not, or would not for practical reasons, further subdivide. Specification at ¶¶ 7, 46-48. Examples of atomic units of work include reviewing documents for typographical information, processing insurance claims, processing accounts payable, writing software modules, designing circuit components, completing proposals, etc. *Id.*

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The selection of individuals to perform atomic units of work, along with a negotiation for a payment per unit of work, is not described in Farenden. Farenden discloses a conventional employment model, which Applicant's specification distinguishes from the atomic unit of work approach. A participant in the Extended Work Program has freedom to choose work hours, geographical location, and type of atomic units of work. Specification at ¶¶ 7, 46-48. Such individual can also choose the amount of work to do. Farenden does not describe the limitations of claims 16-19 pertaining to these features. As discussed during the interview, Farenden simply does not anticipate the subject matter of original or amended claims 16-19.

In addition, the references cited in the rejection in the divisional '459 application, specifically McGovern and Green, do not disclose the claimed invention. There is no motivation cited to combine these references in the manner suggested by the Office Action in the '459 application and neither of these applications discloses the methods claimed in this application.

McGovern purports to describe a more efficient method of "resource planning," which does not involve selecting and contracting with individuals to perform units of work in exchange for payment on a per-unit basis. Green, in turn, does not involve the process of selecting candidates to perform certain types of units of work from a broader pool. Nor does a hypothetical combination of McGovern and Green disclose payment in exchange for the completion of units of work, as the Office Action in the '459 application concedes with the statement that neither reference "teach the actual[] paying of the candidate." This gap, which the Office Action in the '459 application dismisses as "obvious," conclusively demonstrates that even the combination of these references does not result in the method claimed in either the current application or in the '459 application.

Applicant has briefly addressed the McGovern and Green patents in this application simply to point out that the claims in this application are not obvious in view of these references. Applicant reserves the right to address, in response to any non-final Office Action, any rejection based on these or other references.

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VI. Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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